

ATTACHMENT - REMARKS

Claims 1-10, 27-32, 34-37 and 41-43 are pending in the present application. By this Amendment, Applicants have amended claims 4-6, 28, 29, 30, 34, 36 and 41; added new claims 42 and 43; and cancelled claims 11-26, 33 and 38-40. Applicants respectfully submit that the present application is in condition for allowance based on the discussion which follows.

As an initial comment, Applicants gratefully appreciate the Examiner and her supervisor conducting a personal interview with their representative, Mr. Stephen Weyer, and co-inventor, Mr. Mark Norton, who participated by telephone. In accordance with that interview, Applicants have amended various claims to further highlight novel and non-obvious features over the prior art, as well as added new dependent claims 42 and 43, which further distinguish the claimed method over the prior art, as will be discussed further in detail in response to the rejections raised in the outstanding Office Action.

Claim 9 was objected to as being essentially a duplicate of claim 33. By this Amendment, Applicants have cancelled claim 33, thereby obviating the objection to claim 9.

Claims 4-7, 9, 28-33 and 38-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sidoti et al. (U.S. Patent No. 4,590,085) (hereinafter "Sidoti"), in view of Boniello (U.S. Patent No. 4,867,992) (hereinafter "Boniello"). Applicants respectfully submit that claims 4 and 41, as currently amended, are not obvious in view of the cited prior art reference.

Claim 4 recites a method of increasing the amount of linalool in whole bean or ground coffee to be at least 25% higher than the levels of linalool naturally occurring in the whole bean or ground coffee or at least 2,000 µg/kg linalool. Prior to the present inventors' discovery, one of ordinary skill in the art would not have added linalool to produce a final coffee product having 25% higher amounts of linalool or to increase the total amount of linalool in whole bean or ground coffee to be at least 2,000 µg/kg. Contemporaneously filed with this response is a Declaration by co-inventor, Mark Norton (hereinafter "Norton Dec."), which provides evidence as to what one of ordinary skill in the art would have known at the time of the present invention. Although Sidoti states that linalool has previously been added to enhance the flavor of coffee, Sidoti fails to cite any authority for such an assertion (Norton Dec., ¶¶ 6). Nowhere in Sidoti is there any citation or reference to any coffee product which has linalool added to enhance flavor. It is important to note that Sidoti was filed in 1985 and issued as a patent in 1986, and is directed to enhancing the flavor of beer.

In sharp contrast to the lack of authority cited in Sidoti, at the time of the present invention, numerous references in the coffee art provide evidence as to what one of ordinary skill in the coffee art would have known and, accordingly, would have found obvious (Norton Dec., ¶¶ 3-9). At the time of the present invention, linalool was either considered to not be important to the overall flavor of coffee (or drive customer liking) or to actually be an undesirable component in coffee (Norton Dec., ¶¶ 6).

Moreover, although it was alleged that, in view of Boniello, one of ordinary skill in the art would have been led to add linalool to increase the concentrations of linalool to 25, 50 or 100% more, Applicants respectfully submit that, in view of what is known to

one of ordinary skill in the art, one would not have been led to increase the amounts of linalool, as claimed. Further, one of ordinary skill in the art would not have been led to increase the amounts of linalool to be at least 2,000 µg/kg. In the coffee art, one does not add a single flavorant to coffee; rather, one adds multiple coffee components when enhancing the flavor of coffee (Norton Dec., ¶ 8). Therefore, even if one, *arguendo*, were inclined to add linalool to coffee in view of the statement in Sidoti, one would not have been led to add 25% or more linalool or increase the amount of linalool to be at least 2,000 µg/kg, as one would not be adding linalool, by itself, to coffee (Norton Dec., ¶¶ 8 and 9).

Furthermore, increasing the amount of linalool to be 2,000 µg/kg or more provides for a surprising and unexpected result in terms of enhanced coffee flavor. See present specification, paragraphs [0038] and [0039], Table 4 and Norton Dec., ¶ 9. For example, as summarized in Table 4 and discussed in paragraph [0039], the claimed amounts of linalool (i.e., at least 2,000 µg/kg), produced enhanced coffee flavor.

Based on the foregoing, Applicants respectfully submit that claims 4-7 and 9 are not obvious in view of the cited prior art.

With regard to claims 28-30, Applicants further respectfully submit that the recited methods are not obvious over the prior art for at least the same reasons as discussed above with regard to claim 4. Further, claims 28-30 recite a method which produces a whole bean or ground coffee having amounts of added linalool which parallel the amounts of linalool in allowed claims 1-3. Accordingly, Applicants respectfully submit that claims 28-30 are allowable for at least the same reasons as claims 1-3.

With regard to claim 41, Applicants respectfully submit that the prior art fails to teach or in any way make obvious a roast whole bean having a linalool coating, wherein the linalool coating contains linalool in an amount which, with the amount of linalool in the whole coffee bean, results in 25% higher amounts of linalool than present in the whole bean, inside the coating, or at least 2,000 µg/kg. As discussed above with regard to the rejection of claim 4, prior to the present invention, one of ordinary skill in the art would not have been led to increase the amounts of linalool to be 25% higher or to have at least 2,000 µg/kg. Accordingly, one of ordinary skill in the art would not have been led to produce a coffee composition which comprises a coating of linalool on a roast whole bean of coffee. Therefore, Applicants respectfully request that the rejection to claim 41 be withdrawn.

Claims 8, 10, 27, 34 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sidoti, in view of Boniello, further in view of Marmo (U.S. Patent No. 4,311,720) (hereinafter "Marmo"). Applicants respectfully submit that claims 8, 10, 27, 34 and 36 are not obvious in view of the cited prior art for at least the reasons discussed above with regard to claim 4, as Sidoti and Boniello fail to teach or in any way make obvious the subject matter with regard to increased level of linalool, and Marmo, in combination with Sidoti and Boniello, fail to make up the deficiencies with regard to the claimed subject matter.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sidoti, in view of Boniello and Marmo, further in view of Steinke (U.S. Patent No. 4,698,264) (hereinafter "Steinke"). Applicants respectfully submit that claim 35 is not obvious in view of the cited prior art for at least the reasons discussed above with

regard to claim 4, and further since Steinke, individually or in combination with the other cited prior art, fail to teach or in any way make obvious the amount of linalool present.

Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sidoti, Boniello and Marmo, further in view of Balakrishnan (U.S. Patent No. 6,299,926) (hereinafter "Balakrishnan"). Applicants respectfully submit that claim 37 is not obvious in view of the cited prior art which fails to teach or in any way make obvious the claimed amount of linalool.

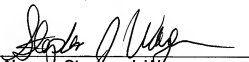
Finally, by this Amendment, Applicants have added new dependent claims 42 and 43, which recite that the amount of linalool added increases the concentration to be at least 3,000 or 4,000 µg/kg, respectively, in the whole bean or ground coffee. Applicants respectfully submit that nowhere in the cited art of record is there any disclosure of adding linalool in the claimed amounts nor would it have been obvious in view of the prior art to add the claimed amounts. Accordingly, Applicants respectfully submit that claims 42 and 43 are further not obvious in view of the cited prior art.

Applicants gratefully appreciate the indication of allowable subject matter of claims 1-3. In view of the foregoing, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner come to a contrary conclusion, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

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Signed By
Attorney of Record


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